THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER J. TWIST

Appeal No. 1996-3824
Application 08/311,635[1]

ON BRIEF

Before WINTERS, METZ and JOHN D. SMITH, ***Administrative Patent Judges***.

METZ, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 5, 7 through 11 and 13 through 20, all the claims remaining in this

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[1] Application for patent filed September 23, 1994.

application.[2]

At page 1 of his brief, appellant informs this Board that appellant's commonly assigned, copending application Serial Number 08/317,977 is currently on appeal. The related co-pending application is directed to an aqueous redox composition and its use for processing photographic materials. Appellant represents that terminal disclaimers have been filed in both cases, an apparent reference to a prospective obviousness-type double patenting rejection.

Said related, copending application is before the same merits panel of this Board as this appeal in Appeal Number 1996-1675. A decision in said appeal was rendered on even date with this decision.

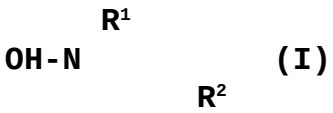
THE INVENTION

The claimed invention is directed to aqueous compositions useful in color photography. The compositions are said to be

[2] Appellant's brief includes claim 6 in the appendix, "Claims on Appeal". Nevertheless, claim 6 was canceled by appellant in Paper Number 8. Accordingly, claim 6 forms no issue in this appeal.

useful as redox amplifiers and comprise, in particular amounts and at a particular pH achieved by the use of a particular phosphate buffer (see appellant's specification at page 4, lines 9 through 12), a color developing agent and hydrogen peroxide or a compound which provides hydrogen peroxide and an hydroxylamine of a particular formula or a salt thereof. Appellant also claims the method of developing an imagewise exposed color photographic element by using appellant's compositions described above.

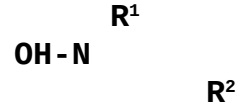
Claims 1 and 10 are reproduced below for a more facile understanding of the appealed subject matter.

> 1. An aqueous redox amplifier composition comprising a colour developing agent, hydrogen peroxide or a compound which provides hydrogen peroxide and a hydroxylamine compound of the formula:
>
> 
>
> **(I)**
>
> or a salt thereof wherein R^1 and R^2 are each a substituted or unsubstituted alkyl group of 1-4 carbon atoms and wherein the concentration ranges are:
>
> hydrogen peroxide from 0.5 to 10 ml/l (as 30% w/w solution),

hydroxylamine compound from 0.5 to 15 ml/l (as an 85% solution of diethylhydroxylamine), and

wherein the composition is buffered by a phosphate to a pH in the range of from 11 to 12.

10. A method for processing an imagewise exposed colour photographic element comprising contacting said element with an aqueous redox amplifier composition comprising a colour developing agent, hydrogen peroxide or a compound which provides hydrogen peroxide and a hydroxylamine compound of the formula:



(I)

or a salt thereof wherein R^1 and R^2 are each a substituted or unsubstituted alkyl group of 1-4 carbon atoms and wherein the concentration ranges are:

hydrogen peroxide from 0.5 to 10 ml/l (as 30% w/w solution),

hydroxylamine compound from 0.5 to 15 ml/l (as an 85% solution of diethylhydroxylamine), and

wherein the composition is buffered by a phosphate to a pH in the range of from 11 to 12.

The references of record which are being relied on by the examiner as evidence of obviousness are:

Nakamura et al. (Nakamura) 4,414,305 November 8, 1983

Wingender et al. (Wingender) 5,200,301 April 6, 1993

Claims 1 through 5, 7 through 11 and 13 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable from the disclosure of Nakamura considered with Wingender. We reverse.

OPINION

The examiner has relied on the disclosure in Nakamura at column 13, lines 17 and 18 for the purpose of establishing that "hydroxylamine or its salt" may be added to an aqueous redox amplifier composition including hydrogen peroxide or a compound which releases hydrogen peroxide and a phosphate buffering agent. Wingender is said to establish that it was known to use 85% by weight diethylhydroxylamine in an amount of 6 ml's as an antioxidant for aqueous redox amplifier solutions as claimed. The examiner has directed our attention to column 14, line 54 of Wingender.

The examiner has reasoned that the hydroxylamine component of Nakamura is "found to be an adjacent homologue to a dimethylhydroxylamine or its salt with $\mathbf{R}^1$ and $\mathbf{R}^2$ in formula (I) as claimed being the methyl groups" (see page 4 of the Examiner's Answer). The examiner concludes that, therefore, it would have been obvious to use dimethylhydroxylamine in

Nakamura because it is the next adjacent homologue of Nakamura's hydroxylamine or it would have been obvious to use Wingender's diethylhydroxylamine antioxidant as an antioxidant in Nakamura's composition for the purpose and advantages disclosed by Wingender.

In the first instance, Nakamura does not disclose hydroxylamine, *per se*, but hydroxylamine sulfate or hydrochloride, both salts of hydroxylamine. We also agree with appellant that the examiner has failed to factually establish a close enough structural similarity between appellant's hydroxylamines of formula (I) and the compounds of Nakamura to trigger the presumption that the routineer would have been motivated to make appellants' compounds based on Nakamura's disclosure. We agree with appellant that hydroxylamine, which contains two primary acidic hydrogen atoms in the molecule, is <u>not</u> an adjacent homologue of dimethylhydroxylamine or its salt.

While Wingender is admittedly directed to aqueous redox amplifier solutions which may include diethylhydroxylamine, hydrogen peroxide and a buffer, the pH's for the various compositions disclosed therein are 7.0 (column 14, lines 32

and 33), 10.6 (column 14, line 62) and 6.0 (column 15, line 8). The examiner has failed to express what would have motivated the person of ordinary skill in the art to select appellant's particular ingredients and use them at a pH ranging from 11 to 12 based on Wingender or Wingender considered with Nakamura. Indeed, while it appears from the voluminous prior art cited in this application that appellant's individual ingredients are, *per se*, known as useful additives for redox amplifying solutions in general, nothing in the record to which our attention has been directed suggests appellant's particular pH, particularly claimed ingredients or particular amounts of ingredients.

For all the above reasons, we find the examiner has failed to make out a *prima facie* case of obviousness with respect to the appealed subject matter. Accordingly, it is unnecessary to discuss the relevance of appellant's alleged evidence of unexpected or surprising results since evidence of nonobviousness is only weighed against evidence which establishes a *prima facie* case of obviousness.

The rejection of claims 1 through 5, 7 through 11 and 13 through 20 under 35 U.S.C. § 103 is **reversed**. The decision of the examiner is **reversed**.

REVERSED

SHERMAN D. WINTERS Administrative Patent Judge	)
ANDREW H. METZ Administrative Patent Judge	)BOARD OF PATENT) APPEALS AND)INTERFERENCES
JOHN D. SMITH Administrative Patent Judge	)

AHM/gjh

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